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Filed : April 6, 2000

REMARKS

By this document, the Applicant has amended Claims 10 and 22. Thus, Claims 1-28 remain pending and are presented for further examination.

I. Discussion of Objection to Claim 22

In paragraph 2 of the Office Action, the Examiner objected to Claim 22 for being dependent on Claim 23, which is not a preceding claim. In response to this objection, the Applicant has amended Claim 22 so it now depends on a preceding claim.

II. Discussion of Rejection of Claims 10-18 Under 35 U.S.C. § 112, Second Paragraph

In paragraph 3 of the Office Action, the Examiner rejected Claims 10-18 for being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More particularly, the Examiner stated that it is unclear which client does the phrase "the client" in Claim 10 refers to, i.e., the first client or the second client. In response to this rejection, the Applicant has amended Claim 10 to more particularly point out that the server is configured to direct the second client to the first client when the "first client" is on-line. Accordingly, the Applicant submits that the rejection to Claims 10-18 is now overcome.

III. Discussion of Rejection of Claims 1-28 Under 35 U.S.C. § 103(a)

In paragraph 5 of the Office Action, the Examiner rejected Claims 1-28 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,026,441 to Ronen in view of U.S. Patent No. 6,480,484 to Morton. In rejecting Claim 1, the Examiner stated that "Ronen teaches the invention substantially as claimed." *O.A. at para. 6*. The Examiner stated that "Ronen does not specifically teach the step of establishing a communication link between the first client and the interactive file of the second client if the second client is disconnected from the network." *O.A. at para. 7*. However, the Examiner stated that "Morton on the other hand teaches the step of establishing a communication link between the first client and the interactive file of the second client if the second client is disconnected from the network" (*citing* to Morton at col. 1, line 66 – col. 2, line 7; col. 2, lines 33-56). *Id.* The Examiner argued that it "would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Ronen and Morton because doing so would take advantage of the full capabilities provided by

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network technologies [Morton, col. 1, lines 44-45] by allowing the first client to obtain the second client even [sic] the second is off-line." The Applicant respectfully disagrees with the Examiner's determination and, for the reasons presented below, submits that it would not have been obvious to a person of ordinary skill in the art at the time the invention was made to recognize the present invention in view of the teachings of Ronen and Morton.

A. Brief Description of U.S. Patent No. 6,026,441 to Ronen

On one hand, Ronen describes a method for establishing a connection on the Internet between applications associated with two or more client terminals. *Ronen at col. 1, ll. 7-10*. An initiating first user at a client terminal who wishes to establish a connection over the Internet with a destination user's client terminal uses the destination user's e-mail address (mary@def.com) to determine the domain name of that users IASP (def.com)." *Id. at col. 2, ll. 3-8*. Using that determined domain name of the destination user's IASP, a DNS is queried to obtain the IP address of that IASP. *Id. at col. 2, ll. 8-10*. After receiving the IP address of that IASP, the application sends a query to that IASP to determine whether an entry exists in a database that associates user names with currently assigned IP addresses. *Id. at col. 4, ll. 14-17*. A determination is made whether such entry does exist (i.e., whether destination party is logged on). *Id. at col. 4, ll. 17-19; see also Fig. 2*. If no entry exists, the application is informed that it cannot connect to the desired end point (i.e., informs the user that connection cannot then be made to the desired destination client terminal). *Id. at col. 4, ll. 19-20; see also Fig. 2*.

B. Brief Description of U.S. Patent No. 6,480,484 to Morton

On the other hand, Morton describes a method and apparatus for automatically retrieving and displaying a greeting web page in response to a caller placing a call to a called party. *Morton at col. 1, line 66 – col. 2, line 1*. The web page presents information related to the called party and gives the caller options for contacting the called party, redirecting the call or obtaining additional information. *Id. at col. 2, ll. 4-7*. Morton's invention provides advantages over a conventional recorded voice greeting and a touch tone user interface, or a personal web page which is not automatically accessed in response to a call attempt. *Id. at col. 2, ll. 12-15*. More particularly, Morton describes a system in which the calling party at telephone 102 and terminal 106 initiates a call the called party at telephone 103 and terminal 108. *Id. at col. 5, ll. 10-12; see*

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also Fig. 4. An identifier for the called party is used to determine the URL for the greeting data associated with the called party at terminal 108 and telephone 103. *Id.* at col. 5, ll. 26-29. The URL is used by client greeting application 203 to invoke the calling party's Web browser 201. *Id.* at col. 5, ll. 38-40. The Web browser application 201 displays the received data for the called party at terminal 106, and the calling party at terminal 106 may view the greeting data associated with the called party and take actions, or wait for the call to proceed. *Id.* at col. 5, ll. 57-63. "The calling party may take these actions whether or not the call is answered." *Id.* at col. 6, ll. 4-5. The calling party at terminal 106 may choose to initiate a call to an alternate destination for the called party, such as telephone 104 or terminal 110. *Id.* at col. 6, ll. 6-28.

C. The Law of Obviousness

To establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation to combine the reference teachings, (2) there must be a reasonable expectation of success, and (3) the references when combined must teach or suggest all of the claim limitations. See M.P.E.P. § 2143. It is well settled that "a showing of a suggestion, teaching or motivation to combine the prior art references is an 'essential component of an obviousness holding'." See, e.g., *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000). The Examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." *In re Fitch*, 972 F.2d 1260, 1265, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). "Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention." *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546 (Fed. Cir. 1998).

The Applicant submits that the Examiner failed to establish a *prima facie* case of obviousness because (1) there is no suggestion or motivation to combine teachings and Ronen and Morton, and, even if there were such a suggestion or motivation, (2) the combined teachings of Ronen and Morton fail teach or suggest all of the limitations of Claim 1.

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D. There is No Motivation to Combine the Teachings of Ronen and Morton

As noted above, Ronen describes that a determination is made as to whether the called party is logged on. *Id.* at col. 4, ll. 17-19; *see also* Fig. 2. If the called party is *not* logged onto the network, the application is informed that it cannot connect to the desired end point (i.e., the user is informed that connection cannot then be made to the desired destination client terminal). *Id.* at col. 4, ll. 19-20; *see also* Fig. 2. On the other hand, Morton teaches that a Web browser application 201 displays data about the called party at the calling party's terminal 106, and the calling party may view the greeting data associated with the called party and take actions, or wait for the call to proceed. *Id.* at col. 5, ll. 57-63. "The calling party may take these actions whether or not the call is answered." *Id.* at col. 6, ll. 4-5.

The Applicant submits that the combination of the teachings of references advanced by the Examiner illustrates a classic hindsight combination of components selectively culled from the prior art to fit the parameters of Applicant's invention, which hindsight is impermissible. *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546 (Fed. Cir. 1998). For example, if one were to selectively combine the teachings of Ronen and Morton, as suggested by the Examiner, informing the calling party that a connection cannot be made with the destination party (Ronen's step 206 of Fig. 2) would serve no purpose, since the display of the called party's web page would be sufficient to give notice. One of ordinary skill in the art would need to modify Ronen by dropping at least step 206. Additionally, as explained in detail in section E below, Morton always displays the called party's web page to the calling party's terminal 106, even when the calling party wants to "wait for the call to proceed [so that] the calling and called parties may converse", i.e., when the called party is *connected* to the network. *Id.* at col. 5, ll. 57-65. Thus, one would have had to reverse Morton's teaching, and add at least the reversed steps 405 and 406 of Morton's Figure 4 to Ronen's teachings.

The Applicant submits that nowhere do these references, and the Examiner did not show how and where do these references, show an objective teaching to one of ordinary skill in the art that would lead that individual to combine the relevant teachings to selectively drop, reverse, and add such steps. *In re Fitch*, 972 F.2d 1260, 1265, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). Accordingly, the Applicant submits that there is no suggestion or motivation to combine teachings and Ronen and Morton, as suggested by the Examiner.

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E. Combined Teachings of Ronen and Morton Fail to Teach/Suggest All Claim Limitations

As noted above, Claim 1 recites a method of communication between a first client and a second client comprising establishing "a communication link between the first client and the interactive file of the second client if the second client is disconnected from the network." As the Examiner correctly noted, Ronen does not specifically teach such step. *O.A. at para. 7*. The Applicant submits that Morton also fails to teach or suggest a method comprising establishing a communication link between the first client and the interactive file of the second client if the second client is disconnected from the network, as recited in Claim 1.

More particularly, Morton describes a method comprising "automatically retrieving and displaying a greeting web page in response to a caller placing a call to a called party", regardless of whether or not the called party is connected to the network. (emphasis added) *Morton at col. 1, line 66 – col. 2, line 1*. In fact, Morton purposefully displays the called party's web page to the calling party's terminal 106, even when the calling party wants to "wait for the call to proceed [so that] the calling and called parties may converse", i.e., when the called party is connected to the network. *Id. at col. 5, ll. 57-65; see also Fig. 4 (displaying of greeting in step 405 occurs before determining if called party answers the call in step 406, and without conditions)*. The calling party may route the call to an alternate destination, such as telephone 104 or terminal 110, "whether or not the call is answered" by the called party. *Id. at col. 6, ll. 2-28*. Thus, Morton establishes a link between the calling party's terminal 106 and the called party web page automatically and without any satisfaction of conditions, i.e., regardless of whether or not the called party is disconnected from the network. Unlike Morton's teachings, Claim 1 recites that establishing a communication link between the first client and the interactive file of the second client is conditional: "if the second client is disconnected from the network." Nowhere does Morton teach or suggest a method comprising establishing a communication link between the first client and the interactive file provided that the second client is disconnected from the network, as recited in Claim 1.

Therefore, even if one of ordinary skill in the art were to combine the teachings of Ronen and Morton, such combination would still fail to teach or suggest all of the elements of Claim 1.

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The Applicant submits that Claim 1 is allowable, and requests that the rejection of Claim 1 be withdrawn.

Since Claims 2-9 depend either directly or indirectly on Claim 1, the Applicant submits that those claims are also allowable for at least the reasons discussed in connection with the allowability of Claim 1. Since each of Claims 10, 19, 25, and 27 includes at least some of the patentable limitations of Claim 1, the Applicant submits that those claims are also allowable.

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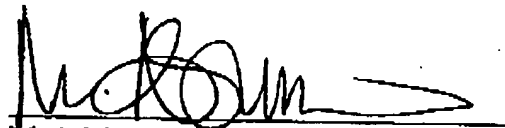
Respectfully submitted,

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